

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 17-18, 20-25, 27, and 30-32 are presently active in this case. The present Amendment amends Claims 17, 20, 21, 23, 27, 30; cancels Claims 16, 19, 26 and 28-29 and adds Claims 31 and 32.

The final Office Action rejected Claims 23-25 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 16, 26 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reed (U.S. Patent No. 6,397,209) in view of Yanase (U.S. Publication No. 2001/0025288). Claims 17-25, 27-28 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Reed in view of Yanase, Thomson (U.S. Patent No. 5,634,051) and Chen (U.S. Patent No. 6,009,442).

In response to the rejection under 35 U.S.C. § 112, second paragraph, Claim 23 is amended to correct the noted informality. In view of amended Claim 23, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

The claims are amended in order to clarify Applicant's invention. The added features find non-limiting support in the disclosure as originally filed, for example in the original claims. Therefore, the changes to the claims are not believed to raise a question of new matter.¹

¹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

In response to the rejections of the claims under 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of these rejections and traverses the rejections, as discussed next.

The inventions of amended claims 17 and 21 include the following features: (i) creating a plurality of summary information based on document data; (ii) creating screen data including the document data and the plurality of summary information; and (iii) displaying the document data and the plurality of summary information on one screen.

In addition, in the invention of amended claim 17, a number of search keys can be selected from the search keys belonging to the same hierarchy level. Thus, the following advantages can be achieved: (i) search keys in the same hierarchy level can be designated flexibly; (ii) the number of searches to be conducted can be reduced; (iii) the user's operability can be improved; and (iv) searches can be conducted according to the user's needs.

On the other hand, the cited references (Reed, Thomson, Yanase and Chen) do not describe that a number of search keys can be selected from the search keys belonging to the same hierarchy level.

Amended claim 21 recites that when a search key in an arbitrary hierarchy is designated by the user, a search is conducted "based on the search key designated in the arbitrary hierarchy and a search key designated in a hierarchy of an order higher than the arbitrary hierarchy before the arbitrary hierarchy is designated". Therefore, the user can easily select a search key from any level of the hierarchy structure (a narrow-down operation).

As described above, the inventions of amended claims 17 and 21 include the following features: (i) creating a plurality of summary information based on document data; (ii) creating screen data including the document data and the plurality of summary

information; (iii) displaying the document data and the plurality of summary information on one screen; and (iv) selecting a number of search keys from the search keys belonging to the same hierarchy level, or selecting a search key from any level of the hierarchy structure.

Therefore, the inventions of amended claims 17 and 21 are not obvious over the inventions of the cited references (Reed, Thomson, Yanase and Chen). Claims 18, 20, 22, 23-25, 27 and 30-32 recite similar features as discussed above with respect to amended Claims 17 and 21. Therefore, even if the combinations of the Reed, Thomson, Yanase and Chen patents are assumed to be proper, the combinations fail to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.² The position that the systems disclosed in the cited references can be modified to arrive at the claimed invention is insufficient to establish a *prima facie* case of obviousness.³

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 17-18, 20-25, 27, and 30-32 is earnestly solicited.

² See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

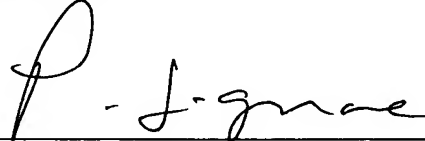
³ See MPEP 2143.01 stating that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness"; see also same section stating "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,'" (citation omitted).

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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